

REMARKS**I. Status of Claims**

Upon entry of this amendment, claims 21-29 and 31-39 are pending in the application. Claims 21 and 36 have been amended. Claims 1-20 and 30 were previously cancelled.

Claims 21 and 36 have been amended as requested by the Examiner. As no new matter has been added, entry of the amendment is respectfully requested.

II. Amendment of Claims to Reflect Election

The pending Office Action notes that this application contains SEQ ID NO:510 as recited in claim 36, which is drawn to an invention nonelected with traverse in the reply filed on February 8, 2008. As requested by the Examiner, claim 36 has been amended to remove the reference to nonelected SEQ ID NO: 508.

III. Information Disclosure Statement

Applicants thank the Examiner for considering the information disclosure statements and the references cited therein filed June 16, 2009 and August 28, 2009.

The Office Action alleges that the submission is not fully compliant with the provisions of 37 CFR §1.97, which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It is alleged that an English translation of Citation No. 37, EP-0345242-A2 has not been provided and that a copy of Citation No. 54, WO 93/19191-A1 cannot be located in the file. Accordingly, No. 37 and No. 54 have not been considered.

Regarding Citation No. 37, Applicants no longer wish to make this reference of record.

Regarding Citation No. 54, Applicants respectfully submit that this reference can be found on PAIR as a foreign reference submitted with the IDS filed August 28, 2009. Please consider the English abstract for this reference.

IV. Priority

Applicants thank the Examiner for acknowledging that the instant claims have been afforded priority to Provisional Application 60/345,637, filed January 8, 2002.

V. Claim Rejections - 35 USC § 103

A. Claims 21-29 and 31-34 and 37

In the previous Office Action mailed January 16, 2009, claims 21-29 and 31-34 and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/21994 ('994). This rejection has been maintained for the reasons of record set forth in the previous Office Action mailed January 16, 2009. Newly submitted claims 38 and 39 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over '994. Specifically, the Office Action alleges the following:

As Applicants note above, the instant specification discloses that DKFZ is also known as VMP1. Therefore, given its broadest reasonable interpretation, and absent a sequence of DKFZ, also known as VMP1 of Applicant's invention, the Examiner has included the disclosure of the '944 application to embrace DKFZ, also known as VMP1 of the claimed invention.

Applicants maintain their traversal of the rejection and the supporting remarks on the previously discussed grounds. Applicants further submit that all of the currently pending claims are directed to "DKFZp5661133", a term which is explicitly defined in the specification at page 5, paragraphs 47 to 48, as referring to the vacuole membrane protein 1 or the sequences defined by NCBI accession number sequences relating to vacuole membrane protein 1. Accordingly, an interpretation of "DKFZp5661133" to encompass the "Human Vesicle Membrane Protein-Like Protein" of the '994 disclosure is not consistent with the explicit definition found in the specification.

In view of the above, Applicants respectfully maintain that the claims are nonbvious in view of the cited art and request withdrawal of the rejection.

B. Claims 35 and 36

In the previous Office Action mailed January 16, 2009, claims 35 and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/21994 ('994) as applied to claims 21-29 and 31-34 and 37 above, and further in view of Dusetti et al. (Biochemical and Biophysical Research Communications, 2002 Vol. 290:641-649), and U.S. Patent No. 6,844,325 ('325). This rejection is maintained (in part) for the reasons of record set forth in the previous Office Action mailed January 16, 2009. The Examiner acknowledges that Dusetti et al. is no longer prior art but maintains the claims are unpatentable over WO 99/21994 ('994) as applied to claims 21-29 and 31-34 and 37 above, and further in view of and U.S. Patent No. 6,844,325 ('325).

Applicants respectfully maintain their traversal of the rejections and the supporting remarks. In order to establish a *prima facie* case for obviousness, three criteria must be met: 1) the cited references must teach or suggest all elements of the claimed invention; 2) there must be a reason or motivation to modify or combine the references; and 3) there must be a reasonable expectation that such a combination would work.

As discussed above, the '994 fails to teach or suggest all elements of the invention. The '325 fails to remedy this deficiency of the '994 application. The '325 relates primarily to various clones over-expressed in breast cancer tumor tissue, none of which include DKFZ. The '325 thus fails to teach that detecting a difference in biological activity and expression level of DFKZ expressed by a cell can be used in methods of identifying cancer therapeutic agents.

For at least the above reasons, the Office has failed to establish a *prima facie* case for obviousness of claims 35 and 36. Withdrawal of the rejection is respectfully requested.

VI. Claim Objection

Claim 21 is objected to on the grounds that the preamble of claim 21 is grammatically incorrect because it incorrectly recites, “A method of identifying *an* cancer therapeutic agent”. As requested, Applicants have amended the claim to correct this grammatical error. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **03-1952** referencing docket no. 223002105200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

In addition, please direct all further communications in this application to:

Lisa Alexander
Novartis Vaccines and Diagnostics, Inc., Intellectual Property – X168
P.O. Box 8097
Emeryville, CA 94662-8097
Tel: (510) 923-3004
Fax: (510) 655-3542

Dated: January 13, 2010

Respectfully submitted,

By /Patricia Tsao/
Patricia Tsao
Registration No.: 50,713
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
(415) 268-6642